REMARKS

Claims 1-7 are pending in the present application and stand rejected. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,698,019 to Frank or German Patent No. 1441336 in view of Chemical Abstracts 120 (M.Y. Shareef et al.).

Applicant has argued that the present Application is patentable over the cited references because they do not suggest an absolute crystal size of less than 10 microns but, rather, the Frank references discloses only an average crystal size of less than 3 microns and the other two references do not disclose any specific crystal sizes. Clearly, an average crystal size of less than 3 microns, as disclosed in Frank, allows for the presence of some crytals of larger 10 microns. The Examiner states that it "does not appear to be true" that Frank does not disclose an absolute crystal size of less than 10 microns. Respectfully, the Examiner did not provide a basis for this conclusion. Frank explicitly states that the crytal size is an "average." (See Frank, col. 2, ll. 62-67; claims 5,7). Further, Frank's statement that the crystals "are essentially of the same size" does not preclude the presence of some crystals over 10 microns. To the contrary, the statement inherently allows for the presence of some crystals outside of the desired size range. This is a critical difference between Frank and the present Application because the present Application does not permit any crystals over 10 microns.

Next, the Examiner states that it is irrelevant whether Frank requires an absolute size range of less than 10 microns because the Applicant's claim 1 makes no mention of "absolute"

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crystal size. However, even though Applicant's claim 1 does not specifically incorporate the word "absolute," the claim clearly conveys the same meaning. Specifically, claim 1 states: ". . . wherein the leucite crystallites possess diameters not exceeding about 10 microns." The term "not exceeding" does not allow for any crystals larger than about 10 microns. Whereas Frank chose to claim an average crystal size, thus allowing for the presence of larger crytals, the Applicant's invention requires that all crystals be within the required range. Accordingly, Applicant's claim 1 does, in fact, require an absolute crystal size of less than about 10 microns.

Next, the Examiner states that Applicant's argument regarding enablement would render Frank invalid and, therefore, the argument is not persuasive. Respectfully, the Examiner has misstated Applicant's argument regarding enablement. Applicant did not argue that Frank does not enable Frank's claims. Rather, Applicant argued that Frank does not enable Applicant's claims. Clearly, the difference is critical because Frank would not be rendered invalid for failing to enable Applicant's claims.

Applicant's original argument regarding enablement is persuasive because Frank does not teach one of skill in the art how to eliminate all crystals larger than about 10 microns. In other words, a person of skill in the art practicing the Frank patent would make a glass-ceramic having an average crytal size of less than 5 or 3 microns, but also containing some crystals larger than about 10 microns. Thus, Frank does not enable each element of Applicant's claims and therefore cannot render the claims unpatentable. *See Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed.Cir,1989) ("In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method.").

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Lastly, the Examiner states that Applicant's statements at the bottom of page 9 of the specification render Applicant's arguments regarding enablement unpersuasive. Specifically, the Examiner states that "applicant states that one of ordinary skill knows how to isolate the small diameter particles." Respectfully, the Examiner has misinterpreted Applicant's statement at page 9. At page 9, lines 5-17, the application provides a detailed description of the preferred method for separating crystals larger than about 10 microns from the porcelain. Then, at lines 16-22, Applicant makes the following statement:

> By virtue of the foregoing treatment, leucite crystallites possessing diameters not exceeding about 10 microns will be separated and isolated from the second porcelain component. It will be understood by those skilled in the art that variations of the foregoing treatment method or other treatment methods or combinations thereof such as jet milling, air classification, floatation, etc. can be employed herein to separate and isolate the small diameter leucite crystallites.

Application, p. 9, ll. 16-22.

When read in proper context, it is clear that the above statement is meant to convey that, in light of the detailed disclosure of the preferred method immediately preceeding it, persons of skill in the art will now understand certain variations of the method and other methods that may be used to separate out all crystals larger than 10 microns. Previously, no such methods were disclosed in the prior art.

For the reasons discussed above, Applicants respectfully submit that Applicant's Claims 1-7 patentably distinguish over Frank in view of or German Patent No. 1441336 or Shareef. Therefore, Applicants request that the Examiner now reconsider and withdraw the rejections of Claims 1-7 under 35 U.S.C. 103(a) as being unpatentable.

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It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' Attorneys.

Respectfully submitted,

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